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20. (New) A composition comprising at least one compound of claim 19.

## REMARKS

### Amendments to the Claims

Claim 1 has been amended to delete NH<sub>2</sub> from the group of substituents for R'. In view of the amendment of claim 1, the dependency of claim 2 has been amended. Claims 19 and 20 have been added to point out more particularly and claim more distinctly the subject matter of the present invention. The addition of claims 19 and 20 is supported by the specification at, for example, page 12, line 5, through page 13, line 19, and page 15, lines 23-24. Therefore, no new matter has been added by way of these amendments.

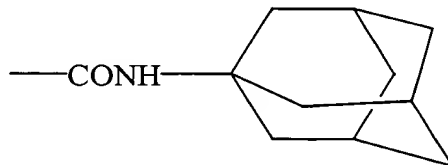
### Restriction Requirement and Election

The Office has set forth a restriction requirement. In particular, the Office Action requires Applicants to elect one of the following groups:

- (I) claims 1-10, drawn to compounds, or
- (II) claims 11-18, drawn to methods of using the compounds of Group I.

Applicants elect, with traverse, the claims of Group I, i.e., claims 1-10.

The Office has also set forth an election of species requirement. Applicants elect, with traverse, the compound wherein R' is (CH<sub>3</sub>)<sub>2</sub>N and R'' is



Claims 1, 7 and 10 of Group I read on the elected species.

#### Discussion of the Restriction Requirement

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." In the case at hand, the Office has failed to meet the criteria for a proper restriction requirement by not even so much as asserting that there would be a serious burden on the Examiner if restriction were not required.

Moreover, as is also stated in M.P.E.P. § 803, mere assertions as to the requirements for restriction are insufficient; rather, "Examiners must provide reasons and/or examples to support conclusions." Here, again, the Office only alleged that the inventions are distinct on the grounds that they are related as product and process of use, citing M.P.E.P. § 806.05(h). Yet, as required by M.P.E.P. § 806.05(h), mere allegation, without support, is insufficient to support a restriction requirement. Rather, "[t]he burden is on the examiner to provide an example...the burden is on the examiner to support a viable alternative use or withdraw the requirement." See, also, "Examiner Note," 2. a) and 2. b), in M.P.E.P. § 806.05(h).

In addition, even if related inventions are shown to be distinct under the criteria of M.P.E.P. § 806.05 (c)-(i), "the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (1) separate classification thereof...(2) a separate status in the art when they are classifiable together...(3) a different field of search." M.P.E.P. § 808.02. Here, the Office has failed to show by appropriate explanation separate classification, separate status in the art when classifiable together, or a different field of search.

Furthermore, the nature of the claims is such that references uncovered by the Office in a search of the claims of Group I would likely be considered by the Office in the examination of the claims of Group II and *vice versa*. For example, claim 11 of Group II recites the compounds of claims 2, 7 and 9 of Group I. In addition, claims 12-18 of Group II recite the compounds of claims 2 and/or 7 of Group I. The Examiner admits as much by stating, "in the event that Group I is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination" (see Office Action, page 2). This is *prima facie* evidence that there would be no undue burden

In re Appln. of Lazarus et al.  
Application No. 09/814,558

on the Examiner. This does not mean that the claims necessarily stand and fall together, but, rather, that the overlapping relevance of references mitigates against a restriction requirement.

Conclusion

For the above reasons, Applicants respectfully submit that the Office has failed to satisfy the requirements for a proper restriction requirement and Applicants request the withdrawal of the restriction requirement. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Carol Larcher", written over a horizontal line.

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Date: September 14, 2001



**PATENT**  
Attorney Docket No. 209897

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Lazarus et al.

Application No. 09/814,558

Filed: March 22, 2001

Art Unit: 1653

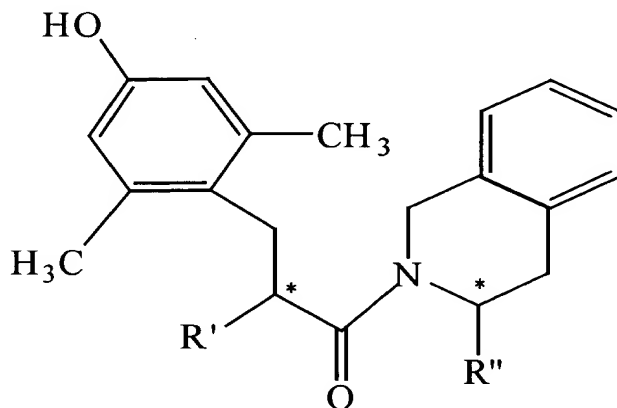
Examiner: D. Lukton

For: DMT-TIC DI- AND TRI-PEPTIDE DERIVATIVES  
AND RELATED COMPOSITIONS AND METHODS OF USE

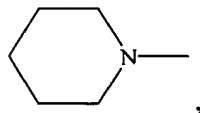
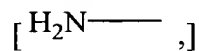
**AMENDMENTS TO CLAIMS  
MADE VIA PRELIMINARY AMENDMENT**

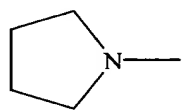
IN THE CLAIMS:

1. (Amended) A compound of formula:

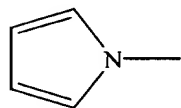


wherein R' is selected from the group consisting of

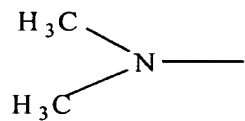




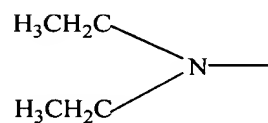
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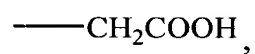


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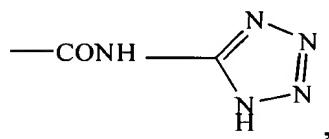
R" is selected from the group consisting of



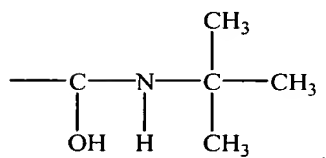
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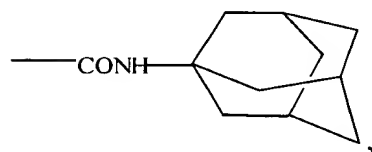
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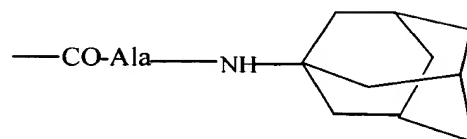
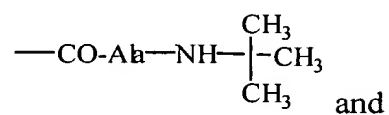
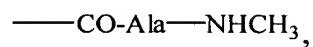
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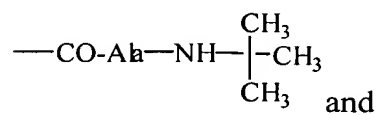
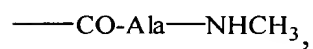
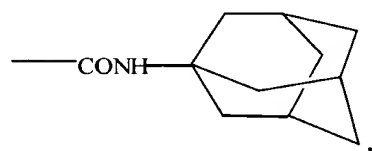
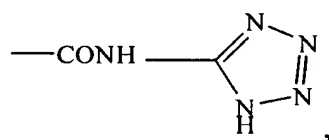
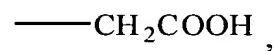
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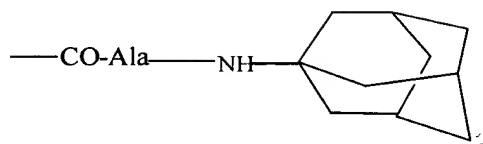


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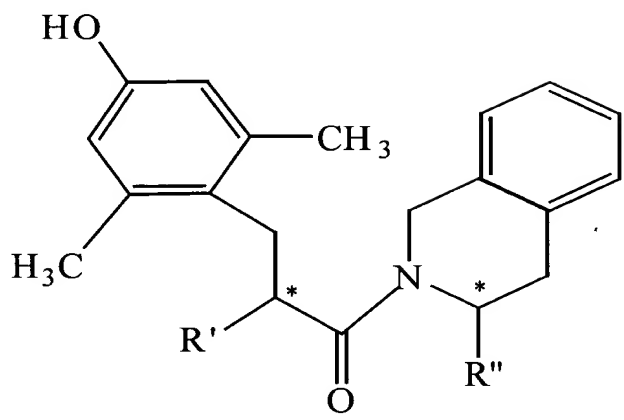


2. (Amended) The compound of claim 19 [1], wherein R' is  $\text{H}_2\text{N---}$  and R'' is selected from the group consisting of

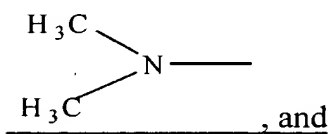
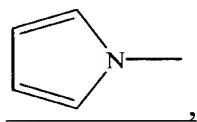
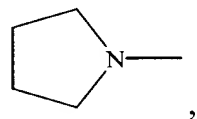
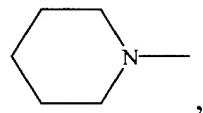


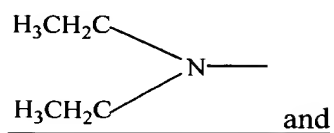


19. (New) A compound of formula:

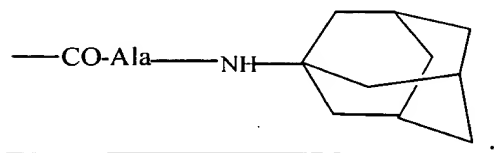
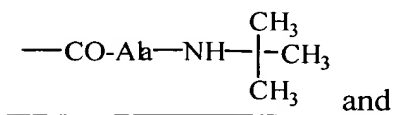
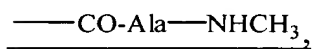
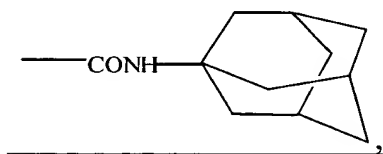
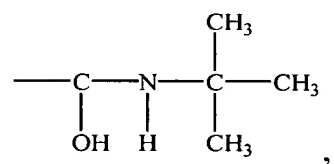
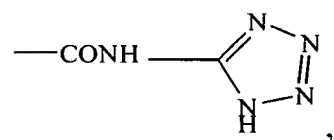
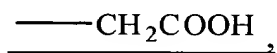


wherein  $R'$  is selected from the group consisting of





R" is selected from the group consisting of



20. (New) A composition comprising at least one compound of claim 19.